



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,527	07/10/2003	Craig Fellenstein	AUS920030364US1	3550
50170 7590 02/21/2008 IBM CORP. (WIP) c/o WALDER INTELLECTUAL PROPERTY LAW, P.C. P.O. BOX 832745 RICHARDSON, TX 75083			EXAMINER JEAN GILLES, JUDE	
			ART UNIT 2143	PAPER NUMBER
			MAIL DATE 02/21/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/617,527

Applicant(s)

FELLENSTEIN ET AL.

Examiner

Jude J. Jean-Gilles

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The finality of the previous Office action has been withdrawn. This action is in Reply to Applicants' request filed on 11/28/2007.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Barra et al (hereinafter Barra), Pub. No. 2002/0104026 A1 in view of Patterson, U.S. Patent No 6,751,670 B1.

Regarding **claim 20**, Barra teaches the invention substantially as claimed. Barra discloses a method for providing electronic mail (e-mail) services (fig. 1), said method comprising:

receiving from an original sender a request for tracing notifications, for an e-mail message (0094);

in response to said request, creating at least one tag for said e-mail message, indicating that said original sender is to receive said tracing notifications (0094; note that the tag in question can be the "action" taken or the "return receipt" confirming special service such

as tracing notification/return receipt services); and receiving at a computing device of the original sender said tracing notifications from one or more non-original recipients in response to (0095-0096). However Barra does not disclose the details of "said e-mail message forwarded by an original recipient to at least one non-original recipient". Nonetheless, this feature is well known and would have been an obvious modification to the system shown by Barra as evidenced by Patterson.

In an analogous art, Patterson teaches a plurality of new recipients receiving forwarded messages not initially intended to them, and notification messages forwarded from those recipients to senders that may be different from the originator/creator (see Patterson, column 5, lines 15-60). In an attempt to promote grating access to email content based on collection of notification information, this technique of forwarding e-mail message forwarded by an original recipient to at least one non-original recipient makes sense.

Given this feature, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system shown by Barra to employ the features of Patterson in order to facilitate forwarding tracing notification from nonintended recipient to the original sender. In referring to fig2B, and 2C, Patterson shows a method of sending tracing notification information from the email recipient to the creator. By this rationale claim 1 is rejected.

Regarding claims 2-33, the combination Barra-Patterson discloses:

Art Unit: 2143

2.(Currently amended) The method of Claim 1, further comprising:

providing limits for said tracing notifications, wherein said providing limits

further comprises one or more limiting actions selected from [[the]] a group consisting of:

limiting the time during which said tracing notifications operate,

limiting the number of retransmissions for which said tracing notifications operate,

limiting said tracing notifications' operation, based on a domain policy, limiting the content of said tracing notifications,

and discontinuing said tracing notifications, in response to a signal from said original sender (see Barra, 0009, 0024, and 0038).

3. (Original) The method of Claim 1, further comprising:

providing to a user a representation of said e-mail message,

together with information as to who has been provided with the content of said e-mail message (see Barra, 0109).

4. (Original) The method of Claim 3, further comprising:

storing and updating said information (see Barra, 0109).

5. (Original) The method of Claim 1, further comprising:

transmitting said tracing notifications to said original sender, from said at least one non-original recipient (see Patterson, column 5, lines 15-60).

6. (Currently amended) The method of Claim 5, wherein said transmitting tracing

notifications further comprises transmitting one or more tracing notifications selected from [[the]] a group consisting of:

Art Unit: 2143

notifications reporting that said message has been sent somewhere in some manner, notifications reporting that the content of said message was provided to said at least one non-original recipient, and notifications reporting deletion of said message (Barra, 0019, and 0082).

7. (Currently amended) A method for providing e-mail services, said method comprising:

in response to a request from an original sender, transmitting tracing notifications to a computing device of said original sender from one or more non-original recipients in response to (see Barra; 0094-0096); and

~~providing limits for said tracing notifications;~~

~~wherein said tracing notifications operate when an e-mail message [[is]] forwarded by an original recipient to at least one non-original recipient (see Patterson, column 5, lines 15-60).~~

8. (Currently amended) The method of Claim 7, further comprising:

providing limits for said tracing notifications, wherein said providing limits further comprises:

limiting the time during which said tracing notifications operate (see Barra, 0009, 0024, and 0038).

9. (Currently amended) The method of Claim 7, further comprising:

providing limits for said tracing notifications, wherein said providing limits further comprises:

Art Unit: 2143

limiting the number of retransmissions for which said tracing notifications operate (see Barra, 0009, 0024, and 0038).

10. (Currently amended) The method of Claim 7, further comprising:

providing limits for said tracing notifications, wherein said providing limits further comprises:

responsive to a signal from said original sender, discontinuing said tracing notifications (see Barra, 0009, 0024, and 0038)..

11. (Currently amended) The method of Claim 7, further comprising:

providing limits for said tracing notifications, wherein said providing limits further comprises:

limiting said transmitting, based on a domain policy (see Barra, 0009, 0024, and 0038)..

12. (Original) The method of Claim 7, wherein said transmitting tracing notifications further comprises:

signaling that the content of said e-mail message has been provided to said at least one non-original recipient (see Barra, 0009, 0024, and 0038).

13. (Original) The method of Claim 7, wherein said transmitting tracing notifications further comprises:

signaling that said e-mail message has been forwarded to said at least one non- original recipient (see Patterson, column 5, lines 15-60).

14. (Original) The method of Claim 7, further comprising:

providing to a user a representation of said e-mail message, together with information as to who has been provided with the content of said e- mail message (see Barra,

Art Unit: 2143

0109).

15. (Original) The method of Claim 14, further comprising:

storing and updating said information (see Barra, 0109).

16. (Currently amended) A system for providing e-mail services, said system

comprising:

means for receiving from an original sender a request for tracing notifications, for an e-

mail message; means responsive to said request, for creating at least one tag for said

e-mail message, indicating that said original sender is to receive said tracing

notifications; and means responsive to said tag, for transmitting said tracing notifications

to a computing device of said original sender from one or more non-original recipients in

response to (see Barra; 0094-0096); and

~~means for providing limits for said tracing notifications;~~

~~wherein said tracing notifications operate when said e-mail message [[is]] forwarded by~~

~~an original recipient to at least one non-original recipient (see Patterson, column 5,~~

~~lines 15-60).~~

17. (Currently amended) The system of Claim 16, further comprising:

means for providing limits for said tracing notifications, wherein said means for

providing limits further comprises:

means for limiting the time during which said tracing notifications operate (see Barra,

0009, 0024, and 0038).

18. (Currently amended) The system of Claim 16, further comprising:

means for providing limits for said tracing notifications, wherein said means for

Art Unit: 2143

providing limits further comprises:

means for limiting the number of retransmissions for which said tracing notifications operate (see Barra, 0009, 0024, and 0038).

19. (Currently amended) The system of Claim 16, further comprising:

means for providing limits for said tracing notifications, wherein said means for providing limits further comprises:

means responsive to a signal from said original sender, for discontinuing said tracing notifications (see Barra, 0009, 0024, and 0038).

20. (Currently amended) The system of Claim 16, further comprising:

means for providing limits for said tracing notifications, wherein said means for providing limits further comprises:

means for limiting said transmitting, based on a domain policy (see Barra, fig. 1).

21. (Original) The system of Claim 16, wherein said means for transmitting tracing notifications further comprises:

means for signaling that the content of said e-mail message has been provided to at least one non-original recipient (see Patterson, column 5, lines 15-60).

22. (Original) The system of Claim 16, wherein said means for transmitting tracing notifications further comprises:

means for signaling that said e-mail message has been forwarded to said at least one non-original recipient (see Barra; fig. 1).

23. (Original) The system of Claim 16, further comprising:

means for providing to a user a representation of said e-mail message, together with

information as to who has been provided with the content of said e-mail message (see Barra, 0109).

24. (Original) The system of Claim 23, further comprising:

means for storing and updating said information (see Barra, 0109).

25. (Currently amended) A computer-usable medium having computer-executable instructions for providing e-mail services, said computer-usable medium comprising:

means for receiving from an original sender a request for tracing notifications, for an e-mail message; means responsive to said request, for creating at least one tag for said e-mail message, indicating that said original sender is to receive said tracing notifications (see Barra; 0094-0096); and

means responsive to said tag, for transmitting said tracing notifications to a computing device of said original sender from one or more non-original recipients in response to (see Barra; 0094-0096; fig. 1); and

~~means for providing limits for said tracing notifications;~~

~~wherein said tracing notifications operate when said e-mail message forwarded by an original recipient to at least one non-original recipient (see Patterson, column 5, lines 15-60).~~

26. (Currently amended) The computer-usable medium of Claim 25, further comprising:

Art Unit: 2143

means for providing limits for said tracing notifications, wherein said means for providing limits further comprises:

means for limiting the time during which said tracing notifications operate (see Barra, 0009, 0024, and 0038).

27. (Currently amended) The computer-usable medium of Claim 25, further comprising:

means for providing limits for said tracing notifications, wherein said means for providing limits further comprises:

means for limiting the number of retransmissions for which said tracing notifications operate (see Barra, 0009, 0024, and 0038).

28. (Currently amended) The computer-usable medium of Claim 25, further comprising:

means for providing limits for said tracing notifications, wherein said means for providing limits further comprises:

means responsive to a signal from said original sender, for discontinuing said tracing notifications (see Patterson, column 5, lines 15-60).

29. (Currently amended) The computer-usable medium of Claim 25, further comprising:
means for providing limits for said tracing notifications, wherein said means for providing limits further comprises:

means for limiting said transmitting, based on a domain policy (see Barra, 0009, 0024,

Art Unit: 2143

and 0038).

30. (Original) The computer-usable medium of Claim 25, wherein said means for transmitting tracing notifications further comprises:

means for signaling that the content of said e-mail message has been provided to at least one non-original recipient (see Patterson, column 5, lines 15-60).

31. (Original) The computer-usable medium of Claim 25, wherein said means for transmitting tracing notifications further comprises:

means for signaling that said e-mail message has been forwarded to said at least one non-original recipient (see Patterson, column 5, lines 15-60).

32. (Original) The computer-usable medium of Claim 25, further comprising:

means for providing to a user a representation of said e-mail message, together with information as to who has been provided with the content of said e-mail message (see Barra, 0109).

33. (Original) The computer-usable medium of Claim 32, further comprising:

means for storing and updating said information (see Barra, 0109).

Conclusion

4. Applicant's remarks necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE NON-FINAL.**

Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn, can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3201.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0800.

Jude Jean-Gilles

Patent Examiner

Art Unit 2143

JJG

February 17, 2008

A handwritten signature in black ink, appearing to read 'Jude Jean-Gilles', is written over the printed name and title.